

**REMARKS**

In the Final Office Action,<sup>1</sup> the Examiner took the following actions:

- 1) rejected claims 1-3, 6-8, and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0065774 to Steiner et al. ("*Steiner*") in view of U.S. Patent No. 6,625,595 to Anderson et al. ("*Anderson*"); and
- 2) rejected claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Steiner* in view of *Anderson* and U.S. Patent No. 6,327,590 to Chidlovskii et al. ("*Chidlovskii*").

Claims 2, 3, 7, 8, 12, and 13 have been canceled, rendering the rejections thereof moot. Claims 1, 4-6, 9-11, 14, and 15 are now pending in this application.

**Rejection of Claims 1, 6, and 11 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1, 6, and 11 under 35 U.S.C. § 103(a) as being unpatentable over *Steiner* in view of *Anderson*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and quotation omitted). "The mere fact that references can be combined or modified does not render the resultant

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<sup>1</sup> The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III). Furthermore, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

A *prima facie* case of obviousness has not been established because the Examiner has not clearly articulated a reason why the prior art would render claim 1 obvious to one of ordinary skill in the art.

Independent claim 1, as amended, calls for a combination including, for example, “a registry [comprising] . . . four information items of a domain of a service, input and output items of a service, restrictions on the input and output items, and a comment sentence.” The prior art fails to teach or suggest at least this element of claim 1.

*Steiner* discloses a “resource providers database.” *Steiner*, para. [0085]. The Examiner argues that “resource providers [of *Steiner*] could be considered [the claimed] information items.” Final Office Action, p. 9. However, in *Steiner*, the database comprising resource providers does not “includ[e] a service domain, input and output items, restrictions on the input and output items, and comments,” as recited in claim 1. Therefore, *Steiner* does not disclose “a registry [comprising] . . . information items including a service domain, input and output items, restrictions on the input and output items, and comments,” as recited in claim 1.

Furthermore, the Examiner argues that “Anderson . . . disclose[s] . . . the search unit outputs the result of the search to the search condition item extracting means when the result of the search specifies a larger number of information services than a specified number of information services.” Final Office Action, p. 3. Even assuming the Examiner’s characterization of *Anderson* is correct, which Applicants do not concede, *Anderson* fails to cure the above-noted deficiencies of *Steiner*. That is, *Anderson* fails to disclose “a registry [comprising] . . . four information items of a domain of a service, input and output items of a service, restrictions on the input and output items, and a comment sentence,” as recited in claim 1. ~~Furthermore~~ <sup>Thus</sup>, the Examiner has failed to clearly articulate the reasons why claim 1 would be obvious to one of ordinary skill in the art in view of the prior art which fails to disclose at least the claimed “registry.” Thus, a *prima facie* case of obviousness has not been established with respect to claim 1.

Independent claims 6 and 11, although different in scope from claim 1, recite elements similar to those discussed above with respect to claim 1. Claims 6 and 11 are allowable over the prior art for at least reasons similar to those given for claim 1. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 1, 6, and 11 under 35 U.S.C. § 103(a).

**Rejection of Claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. §103(a) as being unpatentable over *Steiner* in view of *Anderson* and *Chidlovskii*. A *prima facie* case of obviousness has not been established because the Examiner has failed to clearly articulate a reason why the prior art, taken individually or

in combination, would render Applicants' claims obvious to one of ordinary skill in the art.

As noted above, *Steiner* and *Anderson* fail to disclose all the elements of independent claims 1, 6, and 11. *Chidlovskii* fails to cure this deficiency. That is, *Chidlovskii* also fails to disclose "a registry [comprising] . . . information items including a service domain, input and output items, restrictions on the input and output items, and comments," as recited in claim 1, and required by dependent claims 4, 5, 9, 10, 14, and 15. In view of the above, the Examiner has failed to clearly articulate a reason why the prior art, taken individually or in combination, would render claims 4, 5, 9, 10, 14, and 15 obvious to one of ordinary skill in the art. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 4, 5, 9, 10, 14, and 15 under 35 U.S.C. §103(a).

### **Conclusion**

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

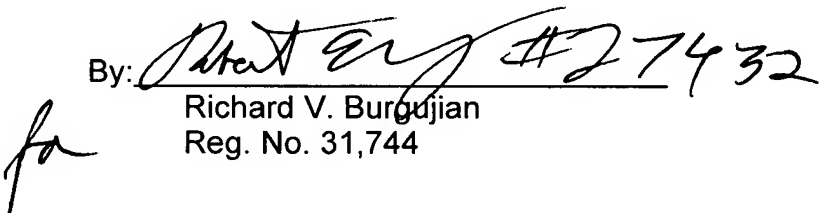
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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